



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/645,401	08/25/2000	Akiko Horiguchi	H&A-100	4524

24956 7590 03/29/2004

MATTINGLY, STANGER & MALUR, P.C.
1800 DIAGONAL ROAD
SUITE 370
ALEXANDRIA, VA 22314

EXAMINER

PARTHASARATHY, PRAMILA

ART UNIT	PAPER NUMBER
----------	--------------

2136

DATE MAILED: 03/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/645,401

Applicant(s)

HORIGUCHI ET AL.

Examiner

Pramila Parthasarathy

Art Unit

2136

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date #2.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to the application filed on 03/14/2003. Claims 1 – 14 were received for consideration. No preliminary amendments to the claims were filed. Claims 1 – 14 are currently being considered.
2. An initialed and dated copy of Applicant's IDS form 1449; Paper No.2 is attached to the Office action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 – 4, 6 – 10, 12 – 14, 16 – 20, 22, and 23 are rejected under 35 U.S.C 102(b) as being anticipated by Deo et al. (US Patent 5,721,781).

Regarding Claim 1, Deo teaches and describes, a sheet-shaped medium having an IC chip which is attached on or put in the medium and which is constructed so that data stored in a memory of the IC chip can be sent in a radio mode by radio communication between the IC chip and a communication device

Art Unit: 2136

or means and also having on its one side at least a portion of the data stored in the memory of the IC chip which is written in an encrypted form (Fig. 6, Column 4 lines 36 – 50, Column 5 line 62 – Column 6 line 5 and Column 8 lines 17 – 33).

Regarding Claim 2, Deo teaches and describes, a sheet-shaped medium having an IC chip which is attached on or put in the medium and which is constructed so that data stored in a memory of the IC chip can be sent in a radio mode by radio communication between the IC chip and a communication device or means and also having on its one side at least a portion of the data stored in the memory of the IC chip and a portion of information written in the medium both which are written in an encrypted form (Fig. 6, Column 4 lines 36 – 50, Column 5 line 62 – Column 6 line 5 and Column 8 lines 17 – 33).

Regarding Claim 3, Deo teaches and describes, a method for the determination of genuineness or counterfeitness of a sheet-shaped medium having an IC chip which is attached on or put in the medium and which is constructed so that data stored in a memory of the IC chip can be sent in a radio mode by radio communication between the IC chip and a communication device or means and also having on its one side at least a portion of the data stored in the memory of the IC chip which is written in an encrypted form (Fig. 6, Column 4 lines 36 – 50, Column 5 line 62 – Column 6 line 5 and Column 8 lines 17 – 33); the method comprising

reading the encrypted data (Column 8 lines 34 – 43),
decrypting the read data (Column 8 lines 34 – 43 and lines 60 – 67), and
verifying the decrypted data against unencrypted data, which is received
from the IC chip (Column 8 lines 34 – 43 and Column 9 lines 29 – 49).

Regarding Claim 4, Deo teaches and describes, a method for the
determination of genuineness or counterfeitness of a sheet-shaped medium
having an IC chip which is attached on or put in the medium and which is
constructed so that data stored in a memory of the IC chip can be sent in a radio
mode by radio communication between the IC chip and a communication device
or means and also having on its one side at least a portion of the data stored in
the memory of the IC chip and a portion of information written in the medium both
which are written in an encrypted form (Fig. 6, Column 4 lines 36 – 50, Column 5
line 62 – Column 6 line 5 and Column 8 lines 17 – 33); the method comprising
reading the encrypted data (Column 8 lines 34 – 43),
decrypting the read data (Column 8 lines 34 – 43 and lines 61 – 67), and
verifying the decrypted data of the difference between the decrypted
against unencrypted data which is received from the IC chip (Column 8 lines 34 –
43 and Column 9 lines 29 – 49).

Regarding Claim 5, Deo teaches and describes, an apparatus for
determination of genuineness or counterfeitness of a sheet-shaped medium
having an IC chip which is attached on or put in the medium and which is

Art Unit: 2136

constructed so that data stored in a memory of the IC chip can be sent in a radio mode by radio communication with an external device and also having on its one side at least a portion of the data stored in the memory of the IC chip which is written in an encrypted form (Fig. 6, Column 4 lines 36 – 50, Column 5 line 62 – Column 6 line 5 and Column 8 lines 17 – 33); the apparatus comprising

a unit for reading and decrypting the encrypted data (Column 8 lines 34 – 43 and lines 60 – 67), and

a unit for verifying the decrypted data against unencrypted data, which is received from the IC chip (Column 8 lines 34 – 43 and Column 9 lines 29 – 49).

Regarding Claim 6, Deo teaches and describes, an apparatus for determination of genuineness or counterfeitness of a sheet-shaped medium having an IC chip which is attached on or put in the medium and which is constructed so that data stored in a memory of the IC chip can be sent in a radio mode by radio communication with an external device and also having on its one side at least a portion of the data stored in the memory of the IC chip and a portion of information written on the medium both which are written in an encrypted form (Fig. 6, Column 4 lines 36 – 58, Column 5 line 62 – Column 6 line 5 and Column 8 lines 17 – 33); the apparatus comprising

a unit for reading and decrypting the encrypted data (Column 8 lines 34 – 43 and lines 60 – 67), and

a unit for verifying the decrypted data against unencrypted data, which is received from the IC chip against the portion of the information written in the medium (Column 8 lines 34 – 43 and Column 9 lines 29 – 49).

Regarding Claim 7, Deo teaches and describes, an apparatus for issuing a certificate, comprising means for holding a sheet-shaped medium having an IC chip which is attached on or put in the medium and which is constructed so that data stored in a memory of the IC chip can be sent in a radio mode by radio communication between the IC chip and a communication device or means and for writing information required for the certificate on one side of the medium (Fig. 6, Column 4 lines 36 – 50, Column 5 line 62 – Column 6 line 5 and Column 8 lines 17 – 33).

Claim 11 is rejected as applied above in rejecting claim 3. Furthermore, Deo teaches and describes a method for the determination of genuineness or counterfeitness of a sheet-shaped medium having an IC chip which is attached on or put in the medium and which is constructed so that data stored in a memory of the IC chip can be sent in a radio mode by radio communication between the IC chip and a communication device or means and also having on its one side at least a portion of the data stored in the memory of the IC chip which is written in an encrypted form (Fig. 6, Column 4 lines 36 – 50, Column 5 line 62 – Column 6 line 5 and Column 8 lines 17 – 33), wherein the sheet-shaped

Art Unit: 2136

medium comprises one member selected from the group consisting of a paper, a plastic and a film with a peel-off sticker (Column 4 lines 36 – 50).

Claim 13 is rejected as applied above in rejecting claim 3. Furthermore, Deo teaches and describes a method for the determination of genuineness or counterfeitness of a sheet-shaped medium having an IC chip which is attached on or put in the medium and which is constructed so that data stored in a memory of the IC chip can be sent in a radio mode by radio communication between the IC chip and a communication device or means and also having on its one side at least a portion of the data stored in the memory of the IC chip which is written in an encrypted form (Fig. 6, Column 4 lines 36 – 50, Column 5 line 62 – Column 6 line 5 and Column 8 lines 17 – 33), wherein the sheet-shaped medium is intended to be used as a life insurance certificate, a non-life insurance certificate, a health insurance certificate, a merchandise coupon, a share certificate, a paper money, a ticket or a passenger ticket (Column 4 lines 63 – Column 5 line 5).

Claim 12 is rejected as applied above in rejecting claim 4. Furthermore, Deo teaches and describes a method for the determination of genuineness or counterfeitness of a sheet-shaped medium having an IC chip which is attached on or put in the medium and which is constructed so that data stored in a

Art Unit: 2136

memory of the IC chip can be sent in a radio mode by radio communication between the IC chip and a communication device or means and also having on its one side at least a portion of the data stored in the memory of the IC chip and a portion of information written in the medium both which are written in an encrypted form (Fig. 6, Column 4 lines 36 – 50, Column 5 line 62 – Column 6 line 5 and Column 8 lines 17 – 33), wherein the sheet-shaped medium comprises one member selected from the group consisting of a paper, a plastic and a film with a peel-off sticker (Column 4 lines 36 – 50).

Claim 14 is rejected as applied above in rejecting claim 4. Furthermore, Deo teaches and describes a method for the determination of genuineness or counterfeitness of a sheet-shaped medium having an IC chip which is attached on or put in the medium and which is constructed so that data stored in a memory of the IC chip can be sent in a radio mode by radio communication between the IC chip and a communication device or means and also having on its one side at least a portion of the data stored in the memory of the IC chip and a portion of information written in the medium both which are written in an encrypted form (Fig. 6, Column 4 lines 36 – 50, Column 5 line 62 – Column 6 line 5 and Column 8 lines 17 – 33), wherein the sheet-shaped medium is intended to be used as a life insurance certificate, a non-life insurance certificate, a health insurance certificate, a merchandise coupon, a share certificate, a paper money, a ticket or a passenger ticket (Column 4 lines 63 – Column 5 line 5).

Claim 8 is rejected as applied above in rejecting claim 7. Furthermore, Deo teaches and describes an apparatus for issuing a certificate, comprising means for holding a sheet-shaped medium having an IC chip which is attached on or put in the medium and which is constructed so that data stored in a memory of the IC chip can be sent in a radio mode by radio communication between the IC chip and a communication device or means and for writing information required for the certificate on one side of the medium (Fig. 6, Column 4 lines 36 – 50, Column 5 line 62 – Column 6 line 5 and Column 8 lines 17 – 33), wherein the apparatus further comprises

a unit for writing required data in the memory of the IC chip (Fig 7, Fig.8, and Column 9 lines 50 – 62 and Column 12 lines 23 – 42).

Claim 9 is rejected as applied above in rejecting claim 7. Furthermore, Deo teaches and describes an apparatus for issuing a certificate, comprising means for holding a sheet-shaped medium having an IC chip which is attached on or put in the medium and which is constructed so that data stored in a memory of the IC chip can be sent in a radio mode by radio communication between the IC chip and a communication device or means and for writing information required for the certificate on one side of the medium (Fig. 6, Column 4 lines 36 – 50, Column 5 line 62 – Column 6 line 5 and Column 8 lines 17 – 33), wherein the apparatus further comprises a unit for encrypting required data and

Art Unit: 2136

writing the encrypted data in the memory of the IC chip (Fig 7, Fig.8, and Column 9 lines 50 – 62 and Column 12 lines 23 – 42).

Claim 10 is rejected as applied above in rejecting claim 7. Furthermore, Deo teaches and describes an apparatus for issuing a certificate, comprising means for holding a sheet-shaped medium having an IC chip which is attached on or put in the medium and which is constructed so that data stored in a memory of the IC chip can be sent in a radio mode by radio communication between the IC chip and a communication device or means and for writing information required for the certificate on one side of the medium (Fig. 6, Column 4 lines 36 – 50, Column 5 line 62 – Column 6 line 5 and Column 8 lines 17 – 33), wherein the apparatus is constructed so that the data stored in the memory of the IC chip is written in the medium in an encrypted form (Fig 7, Fig.8, and Column 9 lines 50 – 62 and Column 12 lines 23 – 42).

Conclusion

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks, Washington, D.C.

20231 **or faxed to:** (703) 872-9306 for all formal communications.

Hand-delivered responses should be brought to Crystal Park II, 2121

Crystal Drive, Arlington, VA, Fourth Floor (Receptionist).

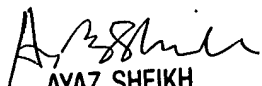
Art Unit: 2136

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pramila Parthasarathy whose telephone number is 703-305-8912. The examiner can normally be reached on 8:00a.m. To 5:00p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Pramila Parthasarathy
Patent Examiner
703-305-8912
March 15, 2004


AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100